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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/649,946      | 08/29/2000  | Alicia Anne Chastain | RSW9-2000-0064USI   | 9155             |

7590 04/21/2004

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EXAMINER

FLYNN, KIMBERLY D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2153

DATE MAILED: 04/21/2004

if

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/649,946

Applicant(s)

CHASTAIN ET AL.

Examiner

Kimberly D Flynn

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 13, 14, 17, 18, 21-26, 28, 34, 35, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) 6, 8-12, 15-16, 19-20, 27, 29-33, and 36-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This application is in response to a request for continued examination filed January 29, 2004. Claims 1-39 are presented for further consideration.

#### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5, 7, 13-14, 17-18, 21-26, 28, 34-35, and 38-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-9, 11-21, 23-24, and 26-27 of copending Application No. 09/650,849. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed the co-pending application.

4. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The subject matter of the instant application is covered by the co-pending application since they are both claiming common subject matter as follows:

Application No. 09/649,946

Application No. 09/650,849

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| <p>1, 13, 22, 34, 38 and 39. A method in a data processing system for automatically creating rules to process electronic messages:</p> <p>detecting user input moving an electronic message into a folder;</p> <p>comparing characteristics of the electronic message with other electronic messages in the folder to form a comparison; and</p> <p>automatically generating a rule to process electronic messages based on the comparison.</p> | <p>1, 8, 16, 23, 26, and 27. A method in a data processing system for automatically modifying rules to process electronic messages:</p> <p>detecting user input moving an electronic message into a folder, wherein the rules is associated with the folder;</p> <p>determining whether the electronic message matches the rule; identifying characteristics of the electronic message if a match between the rule and the electronic message is absent; and</p> <p>automatically modifying the rule using the characteristics to form a modified rule.</p> <p><i>The distinctions would have been obvious because the steps of automatically generating a rule to process electronic messages and automatically modifying rules to process electronic messages are functionally equivalent.</i></p> |
| <p>2 and 23. The method further comprising: processing received messages using the rule.</p>  | <p>2 and 17. The method further comprising: processing received messages using the modified rule.</p>  |

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|  | <i>The distinctions would have been obvious because the claimed subject matter is functionally equivalent.</i>  |
| 3 and 24. The method wherein the processing step is initiated in response to another user input approving use of the rule.   | 3 and 18. The method wherein the processing step is initiated in response to another user input approving use of the modified rule.<br><br><i>The distinctions would have been obvious because the claimed subject matter is functionally equivalent.</i> |
| 4 and 25. The method wherein the criteria includes priority-based common fields and common content.  | 4 and 19. The method wherein the criteria includes priority-based common fields and common content.<br><br><i>No Distinction</i>  |
| 5 and 26. The method wherein the folder is a trash folder.   | 5 and 20. The method wherein the folder is a trash folder.<br><br><i>No Distinction</i>   |
| 7 and 28. The method wherein the criteria includes at least one of a sender address, a selected word, in a subject line body of the electronic message, a select word in a body of the electronic message, and an attribute of the | 6 and 21. The method wherein the characteristics includes at least one of a sender address, a selected word, in a subject line body of the electronic message, a select word in a body of the electronic message, and an                                  |

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| time/date field of the electronic message.  | attribute of the time/date field of the electronic message.<br><br><i>The distinctions would have been obvious because the claimed subject matter is functionally equivalent.</i>   |
| 14 and 35. The method wherein the action is a deletion of the electronic message.   | 9 and 24. The method wherein the manipulation is a deletion of the electronic message.<br><br><i>The distinctions would have been obvious because the claimed subject matter is functionally equivalent.</i>  |
| 17. A data processing system comprising:<br>a bus system;<br>a communications unit connected to the bus system;<br>a memory connected to the bus system,<br>wherein the processing unit executes the set of instructions to identify an action on an electronic message, identify characteristics of the electronic message using a criteria to form a comparison, and automatically generate a rule to process electronic messages including | 11. A data processing system comprising:<br>a bus system;<br>a communications unit connected to the bus system;<br>a memory connected to the bus system,<br>wherein the processing unit executes the set of instructions to detect a manipulation of an electronic message in which a rule is associated with the manipulation, determine whether the electronic message matches the rule, identify characteristics of the electronic |

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| the action and a selected characteristic identified in the comparison.                            | message if a match between the rule and the electronic message is absent, and automatically modify the rule using the characteristics.<br><br><i>The distinctions would have been obvious because the steps of automatically generating a rule to process electronic messages and automatically modifying rules to process electronic messages are functionally equivalent.</i> |
| 18. The data processing system wherein the bus system is a single bus.                            | 12. The data processing system wherein the bus system is a single bus.<br><br><i>No Distinction</i>   |
| 19. The data processing system wherein the bus system includes a primary bus and a secondary bus. | 13. The data processing system wherein the bus system includes a primary bus and a secondary bus.<br><br><i>No Distinction</i>  |
| 20. The data processing system wherein the processing unit includes a plurality of processors.    | 14. The data processing system wherein the processing unit includes a plurality of processors.<br><br><i>No Distinction</i>   |
| 21. The data processing system wherein the communications unit is one of a modem and              | 15. The data processing system wherein the communications unit is one of a modem and  |

|                   |  |
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| Ethernet adapter. | Ethernet adapter.<br><br><i>No Distinction</i> |
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***Allowable Subject Matter***

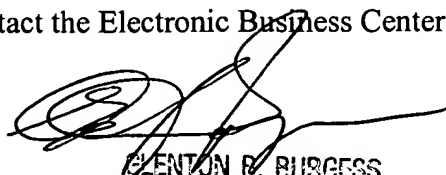
5. Claims 6, 8-12, 15-16, 19-20, 27, 29-33, and 36-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GLEN E. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Kimberly D Flynn  
Examiner  
Art Unit 2153